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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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David J. Kinsella

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03/21/2006

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EXAMINER

GELAGAY, SHEWAYE

ART UNIT

PAPER NUMBER

2137

DATE MAILED: 03/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/982,114	KINSELLA ET AL.	
	Examiner	Art Unit	
	Shewaye Gelagay	2137	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3,4,12 and 13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3,4,12 and 13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/23/06 has been entered.
2. Claims 3-4 and 12-13 are pending.

Claim Objections

3. Claim 13 is objected to because of the following informalities: Claim 13 depends on a rejected claim, claim 11. Applicant may have intended claim 13 to depend on claim 12 instead of claim 11. Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 3 and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by Scott et al. (hereinafter Scott) United States Letter Patent Number 6,484,260.

As per claim 3:

Scott discloses a biometric passkey device configured to perform one or more transactions with a remote computer system without transmitting any biometric information to the remote computer system, the passkey device comprising audit log storage and authorization profile storage of permissible functions, transactions, and remote computer system allowance for a user of the biometric passkey, the device being configured to:

(a) authenticate the identity of a user by comparing the user's unique biometric information with biometric information stored with the passkey device; (Col. 1, lines 56-57 and Col. 4, lines 14-20)

(b) transmit unique passkey device information to the remote computer system to authenticate the identity of the passkey device; (Col. 1, line 61; Col. 2, lines 20-21; Col. 3, lines 28-29; Col. 4, lines 25-34) and

(c) perform one or more transactions with the remote computer system if the identity of the user is first authenticated by the passkey device and the identity of the passkey device is next authenticated by the remote computer system. (Col. 4, lines 20-40 and lines 57-60)

As per claim 12:

Scott discloses a system for performing secure transactions between a biometric passkey device and a remote computer system without transmitting any biometric information to that remote computer system, the system comprising:

(a) a biometric passkey device configured to (i) authenticate the identity of a user by comparing the user's unique biometric information with biometric information stored with the passkey device; (Col. 1, lines 56-57 and Col. 4, lines 14-20) and (ii) transmit unique passkey device information to the remote computer system; (Col. 1, line 61; Col. 2, lines 20-21 and Col. 4, lines 31-32) and

(b) a remote computer system configured to (i) authenticate the identity of the passkey device by comparing the unique passkey device information with device information stored on the remote computer system; (Col. 4, lines 31-33 and lines 58-60) and (ii) allow the passkey device to perform one or more transactions on the remote computer system if the identity of the user is first authenticated by the passkey device and the identity of the passkey device is next authenticated by the remote computer system. (Col. 4, lines 20-40 and lines 57-60)

6. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Scott et al. United States Letter Patent Number 6,484,260 in view of Moriconi et al. United States Letter Patent Number 6,158,010 and further in view of Der Ghazarian et al. (hereinafter Der Ghazarian) United States Letter Patent Number 6,726,636.

As per claim 4:

Scott discloses all the subject matter as discussed above. In addition, Scott further discloses a device with biometric sensor system that can include a fingerprint, a

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voice, or any other type of biometric. (Col. 1, lines 66-67) Scott does not explicitly disclose the device further comprises a substance detection sensor.

Der Ghazarian in analogous art, however, discloses a device further comprises a substance detection sensor. (Col. 3, lines 38-40)

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the device disclosed by Scott et al. to include a device wherein the biometric information may be one of retina scan, DNA recognition, thumb or toe print, or a handwriting sample, the device further comprises a substance detection sensor. This modification would have been obvious because a person having ordinary skill in the art would have been motivated to do so, as suggested by, Der Ghazarian et al. (Col. 3, lines 29-30) in order to provide a versatile system that can perform sobriety test or other test using biometric recognition.

7. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Scott et al. (hereinafter Scott) United States Letter Patent Number 6,484,260 in view of Bapat et al. (hereinafter Bapat) United States Letter Patent Number 6,038,563.

As per claim 13:

Scott discloses all the subject matter as discussed above. In addition, Scott further discloses a biometric personal identification device for providing secure access to a host facility via any wireless transmission over a wireless or wired communication network such as Internet or a private network. (Col. 7, lines 35-49) Scott does not explicitly disclose a device comprising an authorization profile storage or permissible

functions, transactions, and remote computer system allowance for a user of the biometric passkey and an audit log storage.

Bapat in analogous art, however, discloses a device comprising authorization profile storage or permissible functions, transactions, and remote computer system allowance for a user of the biometric passkey and an audit log storage. (Figure 9; Col. 16, lines 32-53; Col. 17, lines 5-11)

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the device disclosed by Scott to include a device comprising authorization profile storage or permissible functions, transactions, and remote computer system allowance for a user of the biometric passkey and an audit log storage. This modification would have been obvious because a person having ordinary skill in the art would have been motivated to do so, as suggested by, Bapat (Abstract) in order to provide an access control system that stores information that specify access right by users to specified set of managed objects and a system for storing an audit trail that stores every access request and the corresponding outcome in the audit trail.

Response to Arguments

8. Applicant's arguments with respect to claims 1-33 have been considered but are moot in view of the new ground(s) of rejection. In response to the arguments concerning the previously rejected claims, the following comments are made:

Regarding claim 3, the Applicant argued the references do not teach “a user authorization profile and permissible functions, transactions, and remote computer system”. In response to applicant's arguments, the recitation “a user authorization profile and permissible functions, transactions, and remote computer system” has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Regarding claim 12, the Applicant argued the references do not teach “a proxy passkey device”. The Examiner disagrees. Scott (U.S. 6,484,260) discloses a personal identification device for providing secure access to a host facility includes a biometric sensor capable of sensing biometric trait of a user that is unique to the user and providing biometric signal indicative of the sensed biometric trait and transmit the verification signal to a host system. (Abstract) A proxy device acts as an intermediary device the user and the server. Therefore, Scott discloses a biometric passkey device (i.e. a portable, hand-held personal identification device) that performs biometric authentication.

Applicant's arguments with respect to claim 13 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See Form PTO-892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shewaye Gelagay whose telephone number is 571-272-4219. The examiner can normally be reached on 8:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on 571-272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Shewaye Gelagay 
3/14/05


EMMANUEL L. MOISE
SUPERVISORY PATENT EXAMINER